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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,684	12/10/2001	Tomomi Izuna	16869S-038700US	9312
20350 7590 02/01/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER THEIN, MARIA TERESA T	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 02/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/006,684

Applicant(s)

IZUNA ET AL.

Examiner

Marissa Thein

Art Unit

3627

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

EL JS acting for Ryan Zender
1/29/07
SPE
Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because: The arguments are not persuasive.

For example, Applicants remark that McCaslin makes absolutely no reference to the specific concept of "renewing" a standard transformer with an energy-saving one.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "renewing" a standard transformer with an energy-saving one) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Nonetheless, the claim does recite replacing or replacement of a transformer. The combination of McCaslin and Dubin discloses this recitation. McCaslin does disclose an equipment information system that includes various tables of data or information. The various modules may include a table maintenance module, an inquiry module, an inventory module, a transportation module and an installation/removal module. (Col. 2, lines 20-26) McCaslin discloses the inventory module providing the capability to receive, track, allocate, deallocate, monitor, and evaluate equipment and orders, such as electrical distribution equipment that includes transformers (col. 5, lines 7-11). Furthermore, McCaslin discloses the method for processing, allocating, and filling an order. An order is received or generated in the equipment information system. Orders may be done manually or automatically generated to reorder equipment at a service center through an external interface. (Col. 9, lines 48-55) Dubin was cited for teaching the measuring circuit of the transformer. Such inventory module which provides the capability to receive, track, allocate, deallocate, monitor, and evaluate equipment and orders, such as electrical distribution equipment that includes transformers; and the method of automatically reordering an equipment are considered replacing or replacement of a transformer.

Applicants remark that the combination of McCaslin, Dubin and Avery fails to teach or suggest "controlling a reply to a received order for a transformer...by sending a first response message including a desired inquiry of a customer relating to an installation date...of a measuring circuit of the transformer".

The Examiner does not agree. In response to applicant's arguments, the recitation "controlling a reply to a received order for a transformer..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The combination of McCaslin, Dubin and Avery does teach or suggest "...by sending a first response message including a desired inquiry of a customer relating to an installation date...of a measuring circuit of the transformer". McCaslin discloses installation/removal module which provides the functionality to manage or determine whether a piece of equipment is installed or is in service or has been removed or is out of service (col. 5, lines 31-34). This module may interface with an external interface, such as a distribution information system, a work management system or a graphical information system (col. 5, lines 40-44). The Work Management Information system (WMIS) provides the capability for personnel in the field, such as engineering personnel, to estimate the particular needs of a job such that the job equipment estimation system will in turn generate the required equipment that is estimated to be needed for the job. The WMIS may provide such equipment needs to the Distribution Equipment Information System (DEIS) along with a need date and location. (Col. 6, line 63 - col. 7, line 5). Furthermore in Figure 11, a graphical user interface shows an Installation History Report which includes the date and service area where the equipment was installed. Dubin was cited for teaching the measuring circuit of the transformer and Avery was cited for teaching the website and email server. Such installation/removal module which provides the functionality to manage or determine whether a piece of equipment is installed or is in service or has been removed or is out of service; the installation/removal module interfacing with an external interface, such as a distribution information system, a work management system or a graphical information system; WMIS may provide such equipment needs to the Distribution Equipment Information System (DEIS) along with a need date and location; and Installation History Report which includes the date and service area where the equipment was installed are considered "by sending a first response message including a desired inquiry of a customer relating to an installation date...of the transformer".